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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,682	10/24/2001	Alan P. Wolffe	8325-0015.20	1541
20855 7590 05/27/2009 ROBINS & PASTERNAK 1731 EMBARCADERO ROAD SUITE 230 PALO ALTO, CA 94303				
EXAMINER ZHOU, SHUBO				
ART UNIT		PAPER NUMBER		
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05/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/083,682

Applicant(s)

WOLFFE ET AL.

Examiner

SHUBO (Joe) ZHOU

Art Unit

1631

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-71 and 125-128 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-71 and 125-128 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

RCE

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/29/08 has been entered.

Status of Claims

Claims 1-65 and 72-124 have been canceled; and claims 66-71 and 125-128 are presently pending and under examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 66-71 and 125-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clontech (Clontech Catalog, 1998-1999, pages 177-183, Clontech Laboratories, Inc., Palo Alto, California) in view of Grosveld et al. (US patent 5,635,355, Jun 3, 1997).

Note that all the above references have been provided to applicants during the prosecution of the application.

Also note that the previous Office action mailed 3/31/05 as affirmed by the Board of Patent Appeals and Interferences in a decision mailed 9/15/08.

It is noted in the amendment filed 12/29/08, the claims are amended such that the claims

are drawn to a library instead of a polynucleotide, and that each polynucleotide of the library comprising a vector and an insert, and each insert sequence consists essentially of accessible regions of cellular chromatin.

The claims, as currently written, are apparently product-by-process claims.

The court in *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 964,966 (Fed. Cir. 1985) holds:

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”

Clontech Catalog discloses multiple genomic libraries made from different organisms with cellular chromatin using different vector systems. See pages 177-183, especially the table on pages 182-183. These genomic libraries are made by a method involving digesting the whole genomes of the chromatin of different organisms with Sau3A I or Mbo I, which are four cutters and are known to digest the genomes with high frequency, and cloning the digested fragments in different vector systems. See page 177. It would be readily apparent to one of skill in the art that the libraries produced by such a method inherently comprise clones that have an insert that either consists of polynucleotide from regions of cellular chromatin that are accessible to reagents such as nuclease and restriction enzymes, as recited in claims 125-128, and that such libraries should comprise clones with an insert that comprises polynucleotides from the accessible region and the inaccessible region. The catalog discloses a plurality of libraries comprising polynucleotides from cellular chromatin of cells at a particular stage of the development, such as from mouse of ages of 9-11 weeks, and adult, and a plurality of libraries

comprising polynucleotides from a particular tissue, such as mouse kidney and mouse liver. See the listing of genomic libraries on pages 182-183. The catalog also discloses a plurality of libraries comprising polynucleotides from healthy and diseased cells, such as normal muscle of *Xenopus laevis* and human Hela S3 cells (from ATCC#CCL2.2, see page 182), which are diseased (cancer) cells and infected with viruses. See the previously provided page 1 of 3 of the printout of ATCC catalog from ATCC's website:

<http://www.atcc.org/SearchCatalogs/longview.cfm?atccsearch=yes>.

Clontech Catalog does not disclose any library where each polynucleotide therein has an insert and each insert consists essentially of accessible regions of cellular chromatin. In other words, in the libraries of Clontech Catalog, there are inserts that do not consist essentially of accessible regions of cellular chromatin.

Grosveld et al. teach a method of preparing nucleic acids which comprise regulatory sequences from a cell (see column 21, claim 1, line 1, for example). The method involves treating isolated nuclei which comprises chromatin with DNaseI, where the enzyme reacts with accessible regions of cellular chromatin (see column 8, lines 17-21), fragmenting the chromatin with a restriction enzyme to generate DNA fragments (column 8, lines 23-25, and contacting DNA fragments of interests from precloned plasmids that contain DNase I hypersensitive sites with a population of vectors to permit ligation of the DNA fragments in order to use it for in vivo introduction. See column 8, lines 1-25, and column 15, lines 43-47. While Grosveld et al. do not clone the Dnase I hypersensitive fragments identified in column 8, Grosveld et al. expressly suggest cloning such fragments because they expressly claim "a method of obtaining a DNA fragment comprising a dominant activator sequence, comprising providing a candidate DNA

fragment comprising a Dnase I hypersensitive site from a genetic locus” ..., and “ligating the fragment to an expressible gene to from a construct.” Such Dnase I hypersensitive fragments should encompass fragments from readily available clones or from the fragments identified in column 8. See claim 1.

One of ordinary skill in the art would have been motivated to modify the method of Clontech and motivated by Grosveld et al. to treat the chromatin with the method of Grosveld et al. and not only clone the Dnase I hypersensitive fragment from a readily made clone containing such fragment if the clone is available, but also to clone the Dnase I hypersensitive fragments directly from the fragments identified in column 8 if there are no clones readily available comprising such fragments in order to obtain such fragments which contain regulatory sequences. There would have been a reasonable expectation of success because such experimental methods of cloning and sequencing fragments of Dnase I digests would have been routine.

Claim Rejections - 35 USC § 112

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 125-128 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are drawn to "the polynucleotide of claim 66" or 125 or 126. The phrase lacks clear antecedent basis because claim 66 is drawn to a library comprising a plurality of polynucleotides, and thus it is not clear which polynucleotide (note the singular form) out of the plurality of polynucleotides of claim 66 is referred to.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran, can be reached on 571-272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Shubo (Joe) Zhou/

SHUBO (JOE) ZHOU, PH.D.

PRIMARY EXAMINER